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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,441	12/01/2000	Wen-mei W. Hwu	042302 0269900	3226

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PILLSBURY WINTHROP LLP
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INTELLECTUAL PROPERTY DEPARTMENT
MCLEAN, VA 22102

EXAMINER

LI, AIMEE J

ART UNIT PAPER NUMBER

2183

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7

Please find below and/or attached an Office communication concerning this application or proceeding.

58



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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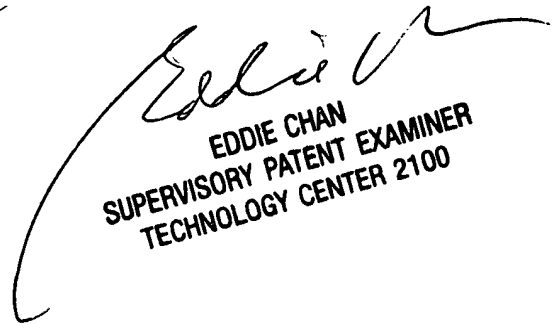
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DATE MAILED:

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Commissioner for Patents

Please find attached a Notice of Non-Compliance and related information.


EDDIE CHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on 05 April 2004 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 *Fed. Reg.* 38611, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following item(s) is required. **Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be resubmitted.** 37 CFR 1.121(h).

THE FOLLOWING CHECKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other: _____
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other: _____
- ☐ 3. Amendments to the drawings: _____
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all claims (including withdrawn claims)
 - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☒ E. Other: New claims 51-52 have been identified with "Newly added" when the proper status identifier should be "New". For more information, please see the attached. Please make the appropriate corrections.

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

If the non-compliant amendment is a **PRELIMINARY AMENDMENT**, applicant is given ONE MONTH from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and **this ONE MONTH time limit is not extendable.**

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION** (including a submission for an RCE), and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a TIME PERIOD of ONE MONTH from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION**, this form may be an attachment to an Advisory Action. The period for response to a final rejection continues to run from the date set in the final rejection, and is not affected by the non-compliant status of the amendment.

REVISED AMENDMENT PRACTICE: 37 CFR 1.121 CHANGED COMPLIANCE IS MANDATORY - Effective Date: July 30, 2003

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: **Changes To Implement Electronic Maintenance of Official Patent Application Records** (68 Fed. Reg. 38611 (June 30, 2003)), posted on the Office's website at: <http://www.uspto.gov/web/patents/ifw/> with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period.

Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.

Note: The amendment practice for reissues and reexamination proceedings, except for drawings, has not changed.

REVISED AMENDMENT PRACTICE

I. Begin each section of an amendment document on a separate sheet:

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

II. Two versions of amended part(s) no longer required:

37 CFR 1.121 has been revised to **no longer require** two versions (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for **substitute specifications** under 37 CFR 1.125 have been retained.

A) Amendments to the claims:

Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, **must include a complete listing** of all claims in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and **the text of each pending claim** (with markings to show **current** changes) must be presented. The claims in the listing will replace all prior claims in the application.

- (1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), **(previously presented) and (not entered)**. The text of all pending claims, **including withdrawn claims**, must be submitted each time any claim is amended. Canceled **and not entered** claims must be indicated by only the claim number and status, without presenting the text of the claims.
- (2) The text of all claims **being currently amended** must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for **deletion of five characters or fewer, double brackets may be used (e.g., [[error]]**; and (2) if **strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]])**. **As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., ~~number 4~~ as number 14 as).** An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings.
- (3) The text of pending claims **not being currently amended, including withdrawn claims**, must be presented in the claim listing in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.

- (4) A claim being canceled must be listed in the claim listing with the status identifier “canceled”; the text of the claim must not be presented. Providing an instruction to cancel is optional.
- (5) Any claims added by amendment must be presented in the claim listing with the status identifier “(new)”; the text of the claim must not be underlined.
- (6) All of the claims in the claim listing must be presented in ascending numerical order. Consecutive canceled, or not entered, claims may be aggregated into one statement (e.g., Claims 1 – 5 (canceled)).

Example of listing of claims (use of the word “claim” before the claim number is optional):

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

B) Amendments to the specification:

Amendments to the specification, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per 37 CFR 1.125.

The changes in any replacement paragraph or section, or substitute specification must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]]; and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number “4” or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as)

C) Amendments to drawing figures:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations. Any replacement drawing sheet must be identified in the top margin as “Replacement Sheet” and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. Any marked-up (annotated) copy showing changes must be labeled “Annotated Marked-up Drawings” and accompany the replacement sheet in the amendment (e.g., as an appendix). The figure or figure number of the amended drawing(s) must not be labeled as “amended.” If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to: Elizabeth Dougherty or Gena Jones, Legal Advisors, or Joe Narcavage, Senior Special Projects Examiner, Office of Patent Legal Administration, by e-mail to patentpractice@uspto.gov or by phone at (703) 305-1616.



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Revised Amendment Practice

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A. Preliminary Amendments

A1. If an application is filed with a preliminary amendment to add several new claims, does the preliminary amendment have to include a complete listing of all claims in compliance with revised 37 CFR 1.121? (posted August 14, 2003)

Yes, the preliminary amendment must be filed in compliance with revised 37 CFR 1.121 with a complete listing of the claims. The new claims should have the status identifier, "new".

Applicant should not use the status identifier, "original" for the claims added in the preliminary amendment, even if the application was filed with an oath or declaration that has a statement referring to the preliminary amendment.

If applicant files a subsequent amendment that includes a complete listing of the claims, applicant should use the status identifier, "previously presented" (if the claims added in the preliminary amendment are not being amended), or "currently amended" (if the claims added in the preliminary amendment are being amended).

Filing an application with a preliminary amendment is not recommended. Applicants are encouraged to file the application with a specification that includes the desired set of claims. See File Continuation or Divisional Application with a New Specification and Copy of Oath or Declaration from Prior Application, 1251 Off. Gaz. Pat. Office 54 (October 9, 2001).

A2. Can I use the transmittal letter of a continuation or divisional application to amend the first sentence of the specification to add the benefit claim to the parent application? (posted August 14, 2003)

No, a preliminary amendment cannot be made in a transmittal letter or form for the filing of an application. The amendment to the specification that adds the specific reference to the parent application in the first sentence of the specification following the title must be provided on a separate sheet of paper in compliance with revised 37 CFR 1.121.

Applicant may wish to provide the specific reference in an application data sheet (ADS) under 37 CFR 1.76 or in a new specification instead of filing a copy of the specification of the parent application with a preliminary amendment.

The Office transmittal forms will no longer permit any preliminary amendment to be made in the transmittal form. If applicants are using a transmittal form that provides a box for a preliminary amendment, applicants are advised not to use such box, but to provide the preliminary amendment on a separate sheet of paper in compliance with revised 37 CFR 1.121.

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B. Claims

B1. May I submit a complete claim listing in a reply when I am not making any changes to the claims, such as responding to a restriction requirement or merely arguing a rejection? (posted August 14, 2003)

Yes. Although a complete claim listing is only required whenever changes are made to any claims, one may be submitted in a reply to an Office action where no changes are being made. It is beneficial to the examiner (and all viewers of the electronic file) to have the most up-to-date set of claims in the most recent paper submitted by the applicant. Note that the claim listing in this situation would not include any claims with markings or any claims with the status identifiers of (new) or (currently amended).

B2. How should I amend a formula in a claim? (posted August 21, 2003)

Applicants may use one of the following methods, for example, change "H4" to "H2" in a chemical formula:

(1) Strikethrough and underlining the whole formula.

Claim 1 (currently amended) A curing agent for epoxy resins comprising pyromellitic dianhydride, C6H4 (C2O3)2 C6H2 (C2O3)2.

(2) Doublebrackets and underlining the whole formula.

Claim 1 (currently amended) A curing agent for epoxy resins comprising pyromellitic dianhydride, [[C6H4(C2O3)2]]C6H2 (C2O3)2.

(3) Delete the claim and replace it with a new claim.

Claim 1 (canceled).

Claim 2 (new) A curing agent for epoxy resins comprising pyromellitic dianhydride, C6H2 (C2O3)2.

Do not use strikethrough or doublebrackets to delete only subscript "4" and use underlining to add only subscript "2" in the formula.

B3. In the past, I have included claim status that indicates how many times a claim has been amended, i.e., "Claim 1 (Twice Amended)." Is it proper to indicate that a claim has been "previously amended twice" or "currently amended for the third time?" (posted August 21, 2003)

No, under the revised amendment practice, it would NOT be appropriate to indicate how many times a claim has been amended. Only the following seven status identifiers are permitted: "original", "currently amended", "canceled", "new", "withdrawn", "previously presented", and "not entered".

B4. May I submit a complete claim listing in a reply when I am not making any changes to the claims, such as responding to a restriction requirement or merely arguing a rejection? (posted August 21, 2003)

Yes. Although a complete claim listing is only required whenever changes are made to any claims, one may be submitted in a reply to an Office action where no changes are being made. It is beneficial to the examiner (and all viewers of the electronic file) to have the most up-to-date set of claims in the most recent paper submitted by the applicant. Note that the claim listing would not include any claims with markings or any claims with the status identifiers of (new) or (currently amended).

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electronic submissions, ePAVE will validate the format, display it to the filer, prompt for the filer's electronic signature, use the filer's digital certificate (an appropriate digital certificate may be obtained from the Office's Electronic Business Center) to encrypt the whole package, and transmit the submission to the Office. Upon receipt, the Office will send to the filer an electronic "Acknowledgment Receipt," including a server date stamp, a unique server number, the application number, and confirmation of the number of the files received by the Office. If the IDS submission is subsequent to the application filing, the filer will be required to enter both an application number and a confirmation number. A confirmation number is an additional four-digit identifier assigned to an application, and can be found in the upper left-hand corner of the official filing receipt. A filer will be required to have a customer number, obtained from the Office's Electronic Business Center, and an Office provided digital certificate to use EFS as with current practice.

Section 1.99

Section 1.99 has been amended to provide that the Office will not enter any explanation of the patents or publications, or any other information (that is not limited to patents or publications) included in a submission. The Office will also not enter a submission that is not in compliance with the requirements of § 1.99. The Office is capturing electronic images of all documents that form the Official file of certain applications and the original paper documents, if stored, will be stored off-site and will not be easily accessible, and if destroyed, will not be available. Therefore, any submission, or part of the submission, that is not in compliance with § 1.99 would not be captured as electronic images and, if such documents have been entered into the Official file, the Office will electronically remove the documents from the Official file.

Paragraph (d) of § 1.99 has been amended by deleting the word "dispose of" and replacing it with "not enter." Paragraph (e) of § 1.99 has been amended by deleting the phrase "returned or discarded" and replacing it with "will not be entered."

Section 1.121

The manner of making amendments to the specification, claims and drawings in non-reissue applications has been revised to permit greater navigational control during examination in an image file wrapper environment.

Paragraph (b) continues to provide the manner of making amendments to the specification and further provides that its provisions do not apply to making amendments to the claims, computer listings or sequence listings. Paragraph (b) has been revised to require a particular format of marking to show changes and also to eliminate the requirement to provide a clean copy of any revised paragraph or section.

Paragraph (b)(1) provides the manner of making an amendment to delete, add or replace a paragraph. It also explicitly provides that amendments to section headings or the title of the invention are to be made as if the section heading or title were a paragraph.

Paragraph (b)(1)(i) continues to require that an amendment include an instruction that unambiguously identifies the location, in the specification, of the paragraph to be deleted or replaced, or where a new paragraph is to be added.

Paragraph (b)(1)(ii) provides that any replacement paragraph must include markings to show all changes relative to the immediate prior version of the paragraph. Added subject matter must be shown by underlining the added text. If any paragraph is being marked-up to show added subject matter and at least part of the added subject matter is to be underlined itself following entry, then the subject matter intended to include underlining that is being added may be shown by double underlining that part of the added text. Deleted subject matter must be shown by striking through the deleted text with two exceptions: (1) For deletion of five characters or fewer, double brackets may be used (e.g., [[error]]); and (2) if strike-through cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change. The requirement to provide a clean version of the replacement paragraph has been eliminated. Examples of typical amendments in the revised practice will be available on the Office's Internet Web site (<http://www.uspto.gov>).

Recognizing that some word processing software will automatically generate a vertical line in the margin adjacent marked-up changes, the Office will not object to the inclusion of a vertical line in the margin of amendments to the specification or claims. As an alternative to providing an amendment to the first line of the

specification to make the reference required by § 1.78 to claim the benefit of a prior application, the Office will continue the practice under § 1.76 to accept an application data sheet that includes the required reference in § 1.78 to claim the benefit of a prior application.

Paragraph (b)(1)(iii) provides that when a paragraph is added to the specification, the text of the new paragraph must not be underlined.

Paragraph (b)(1)(iv) provides that the amendment paper must not include a marked-up version of a deleted paragraph. Where applicant has used the optional paragraph numbering system set forth in § 1.52(b)(6), an appropriate instruction to delete a paragraph would be "Please delete paragraph 0016." Applicants may also include the first and/or last few words of a paragraph to uniquely identify the paragraph to be deleted. An appropriate instruction would be "Please delete the paragraph beginning 'Potash may be obtained' on page 16."

Paragraph (b)(2)(i) continues to require that an amendment include an instruction which unambiguously identifies the section heading of the section of the specification being replaced.

Paragraph (b)(2)(ii), like its counterpart paragraph (b)(1)(ii), has been revised to require that any replacement section must include markings to show all changes relative to the immediate prior version of the section. Added subject matter must be shown by underlining the added text. If the replacement section being marked-up to show added subject matter and at least part of the added subject matter is to be underlined itself following entry, then the subject matter intended to include underlining that is being added may be shown by double underlining that part of the added text. Deleted subject matter must be shown by striking through the deleted text with two exceptions: (1) for deletion of five characters or fewer, double brackets may be used (e.g., [[error]]); and (2) if strike-through cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change. Recognizing that some word processing software will automatically generate a vertical line in the margin opposite marked-up changes, the Office will not object to the inclusion of a vertical line

in the margin of amendments to the specification or claims. Paragraph (b)(2)(ii) has also been revised to eliminate the requirement to provide a clean version of the replacement section. Examples of typical amendments in the revised practice will be available on the Office's Internet Web site (<http://www.uspto.gov>).

Amendments to the abstract of the disclosure should be included in that portion of applicant's amendment document which presents amendments to the specification. Where the amendments to the abstract are minor in nature, *i.e.*, purely grammatical in nature or a limited number of additions or deletions of subject matter are presented, the abstract should be provided as a marked-up version using strike-through and underlining as the methods to show all changes relative to the immediate prior version. Where the abstract is being substantially rewritten and the amended abstract bears little or no resemblance to the previously filed version of the abstract, a new (substitute) abstract may be provided in clean form accompanied by an instruction for the cancellation of the previous version of the abstract. The text of the new abstract must not be underlined. It would be counterproductive for applicant to prepare and provide an abstract so riddled with strike-through and underlining that its meaning and language are obscured from view and comprehension. Whether supplying a marked-up version of a previous abstract or a clean form new abstract, the abstract must still comply with § 1.72(b) requirements regarding length and placement of the abstract on a separate sheet of paper.

Paragraph (b)(3) has been rewritten to reflect a concurrent revision to § 1.125. Although the requirement for a clean form, or version without markings, of a replacement paragraph or section of the specification has been eliminated, the Office maintains the need for a clean form and a marked-up version of a substitute specification. Since substitute specifications generally include many changes, the clean version will assist the examiner to view the substitute specification without distractions from the markings. The marked-up version will assist the examiner in readily ascertaining those changes being made and to alert the examiner to the presence of any new matter. Amendment by substitute specification is permissible where, as set forth in § 1.121(b)(3)(i), an instruction to replace the specification is submitted and, as set forth in § 1.121(b)(3)(ii), the substitute specification is provided in compliance

with §§ 1.125(b) and (c). Section 1.125(b) continues to require that a substitute specification be accompanied by a statement that it includes no new matter. Section 1.125(c) now requires that two versions of the substitute specification be provided. One version must be submitted with markings showing all changes (strike-through, or in some cases double brackets, indicating subject matter being deleted and underlining indicating subject matter being added) relative to the immediate prior version of the specification of record. An accompanying clean version (without markings) must also be supplied.

Strike-through and underlining features are available in most, if not all, commercially available word processing systems. Often times these features are located and activated through a "format" menu, which allows the user to create text, which is struck through or underlined, or highlight text already presented. In the latter case, previously presented text may be selected and strike-through or underlining engaged such that the text is marked in the desired fashion. Additionally, some word processing systems offer editorial tools that permit a user to automatically "track changes" made when editing a document. These editorial tools frequently use strike-through as the manner in which to indicate deleted subject matter and underlining as the manner in which to indicate added subject matter. To clearly identify a line or a section of a document in which changes have been made, these editorial tools may place a vertical line in the left or right margin of the document directly adjacent to the line or section of text in which the changes occur. The presence of such vertical lines in the left or right margin of a replacement paragraph or section of the specification or a marked-up version of a substitute specification is acceptable.

Deleted subject matter may also be indicated in some circumstances by double brackets placed at the beginning and the end of the deleted text. Double brackets must be used if the deleted text would not be easily perceived using strike-through. For example, changing "4 corners" to "three corners" should be indicated by "three [4] corners" rather than "three4 corners" (the strike-through being obscured by the horizontal line in the "4"). Double brackets may also be used to indicate the deletion of five or fewer consecutive characters. Alternatively, the use of strike-through and/or underlining to show the deletion and/or addition of punctuation marks or difficult to perceive characters may, in the

replacement paragraph or rewritten claim, encompass portions of text before and after the punctuation marks or characters. Examples of typical amendments in the revised format will be available on the Office's Internet Web site (<http://www.uspto.gov>).

The prior requirement made in §§ 1.121(b)(1)(ii) and (b)(2)(ii) to provide a clean form, or version without markings, of a replacement paragraph or section to the specification has been eliminated.

Paragraph (b)(4) remains unchanged.

New § 1.121(b)(5) has been added to provide that once a paragraph, section, or specification is amended in a first amendment document, re-presentation of the amended material in subsequent amendment documents is not necessary unless it is amended again or a substitute specification is provided.

Paragraphs (c)(1) through (c)(3) have been replaced with revised §§ 1.121(c) and (c)(1) through (c)(5). Paragraph (c) as revised provides for a total rewriting of a claim each time the claim is amended, including markings to show the changes being made relative to the immediate prior version of the claim, except when the claim is being canceled. Section 1.121(c) also requires submitting a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, and the status of each and every claim in every amendment document that includes an amendment to the claims. This listing, if entered, replaces all prior versions of the claims in the application. Inclusion of the claim status is required for each claim in each claim listing and must be indicated in a parenthetical expression following the claim number. The status of all claims in the application, even those previously canceled or withdrawn, must be indicated in the claim listing.

The status of each claim included in the claim listing must be described by one of the following seven defined identifiers in parentheses after the claim number:

(Original): Claim filed with the application

(Currently amended): Claim being amended in the current amendment document

(Canceled): Claim deleted from the application.

(Withdrawn): Claim still in the application, but in a non-elected status.

(Previously presented): Claim added or amended in an earlier amendment document.

(New): Claim being added in the current amendment document.

(Not entered): Claim presented in a previous amendment document but which has either not been entered or the status of entry is unknown to applicant when a subsequent amendment to the claims is filed.

The status identifier "previously presented" must be used in those circumstances where: (1) A claim has been previously presented as "new" in a prior amendment document and entry of the claim is certain; and (2) a claim has been previously presented as "currently amended" in a prior amendment document. "Previously presented" should not be used for a claim which was previously presented in a prior amendment document, most particularly an after final amendment, and entry of the claim was denied or applicant is uncertain at the present time whether or not the claim has been approved for entry. The status of "not entered" should be used for such claims. It is foreseen that the latter described scenario could occur in those situations where a first after final amendment has been filed and applicant desires to file a second after final amendment prior to receiving a notice of allowance or an advisory action notifying the applicant whether or not claims presented or amended in the first after final amendment have been entered. Thus, the status of "not entered" should be used for claims which have not been approved for entry, or if it is not known if they have been approved for entry.

Patent Cooperation Treaty (PCT) amendment procedures (*i.e.*, PCT Articles 19 and 34(2)(b)) are applicable during the international stage of an international application, and thus status identifiers are not to be used during the international stage. During the national stage (pursuant to 35 U.S.C. 371), amendment rules under § 1.121 apply to preliminary and subsequent amendments. When submitting these amendments in national stage, a claim listing is required with status identifiers indicated in a parenthetical expression following the claim number. The status identifier may indicate that claims were "original," "previously presented," or "canceled" based on changes made during the international stage. More specifically, in an amendment under § 1.121 in national stage, the status identifier "original" must be used for claims that had been presented on or by the international filing date and not modified or canceled. The status identifier "previously presented" must be used in any amendment submitted during national stage for all claims added or modified under PCT Articles

19 or 34 in the international stage that were subsequently entered in the national stage. Similarly, the status identifier "canceled" must be used in any amendment submitted during national stage for any claims canceled under an Article 19 or 34 amendment in the international stage that was subsequently entered in the national stage. If the amendment under § 1.121 in the national stage is making a change in a claim, the status identifier "currently amended" must be used for that claim.

The Office will continue the current practice of entering all previously filed unentered after final amendments and amendments filed with a request for continued examination (RCE) under § 1.114, unless applicant instructs otherwise. Absent specific instructions for entry, these amendments will be entered in the order in which they were filed. See MPEP § 706.07(h) (page 700–85). The claim listing in the most recent amendment will be used as the current claim listing. When applicant submits an amendment after final or an amendment with an RCE, the markings in the text of the claims should be made relative to the claims of the last entered amendment (or the original claims if no amendments have been entered). When filing an RCE, applicants are encouraged to present a comprehensive amendment that includes all of the desired changes previously presented in the unentered after final amendments along with specific instructions not to enter the after final amendments.

When claims are added, they must be numbered consecutively beginning with the number next following the highest numbered claim previously presented, whether entered or not. See § 1.126. Therefore, the claim listing in any after final amendment, or amendment filed with an RCE, should include the claim number(s) for any unentered new claims submitted in a previously filed after final amendment, the status identifier should be indicated as (not entered) and the text of such claims must not be presented. Consecutive unentered claims may be aggregated into one line (*e.g.*, claims 20–25 (not entered)) in the claim listing. If applicant wishes to represent the previously submitted but unentered new claims, the claim listing must include the new claims with claim numbers beginning with the number next following the highest numbered claim previously presented. The new claims must include the status identifier "new" and the text of the new claims.

The Office will also continue the current practice of entering unentered after final amendments that the examiner has indicated would be entered upon the filing of an appeal.

Absent specific instructions for entry, these amendments will be entered in the order in which they were filed. The claim listing in the most recent amendment will be used as the current claim listing.

Combining the status identifiers (withdrawn) and (currently amended) into a single status identification, *e.g.*, (withdrawn—currently amended), may be used in those situations where a claim has been previously withdrawn as non-elected but applicant wishes to amend the claim in an effort to rejoin the withdrawn (non-elected) claim with the elected invention. In all other situations only a single status identifier may be used.

As a result of the changes to § 1.121, each amendment document will be self-contained, as it sets forth a complete listing of all claims, including the text of all pending claims, for examination and provides the status of all of the claims in one location in the file.

Paragraph (c)(1) provides for the presentation of the claims in ascending numerical order. This prevents the grouping of claims by status (all "new" claims together, all "currently amended" claims together, etc.), and ensures a complete listing of all claims in numerical order, regardless of status. Consecutive "canceled" or "not entered" claims, however, may be aggregated (*e.g.*, "Claims 1–5 (canceled)"). Further, paragraph (c)(1) requires that any sheet of an amendment paper including part of the text of a claim shall not include material directed to any other part of the amendment or any remarks concerning the claims. In other words, the complete listing of all of the claims must commence on a separate sheet of the amendment document. This requirement facilitates indexing of the application papers.

Paragraph (c)(2) requires that markings be provided in claims to show the addition or deletion of subject matter. Added subject matter must be shown by underlining. If any claim is being marked-up to show added subject matter and at least part of the added subject matter is to be underlined itself following entry, then the subject matter intended to include underlining that is being added may be shown by double underlining that part of the added text. Deleted subject matter must be shown by striking through the deleted text with two exceptions: (1) For deletion of five characters or fewer, double brackets may be used (*e.g.*, [[eroor]]); and (2) if strike-through cannot be easily perceived (*e.g.*, deletion of the number "4" or certain punctuation marks), double brackets must be used (*e.g.*,

[[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change. This section eliminates the previously accepted use of equivalent marking systems. No other methods of markings or comparison (other than underlining, strike-through or double brackets) are permitted. Only claims of the status "currently amended," or "withdrawn" if also being amended, shall include markings showing changes made. Examples of typical amendments in the revised format will be available on the Office's Internet Web site (<http://www.uspto.gov>).

Paragraph (c)(3) requires that the current amendment document also include the submission of a clean version, *i.e.*, without any markings in the presentation of text, of all pending and withdrawn claims not being amended, but being included as part of the claim listing in the current amendment document. The presentation of a clean version in any "original," "previously presented," or "withdrawn" claim constitutes an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims of the (current) status of withdrawn or previously presented. This relieves the Office of the burden of cross-reading various versions of the same claim to ensure accuracy of rewritten claims. Any claims added by amendment must be indicated with the status of "new," presented in clean version, and shall not be underlined.

Paragraphs (c)(4)(i) and (ii) set forth when claim text must not be presented and that cancellation of any claim is effected by mere instructions to cancel. Alternatively, identifying the status of a claim in the complete listing of all claims as "canceled" will constitute an instruction to cancel the claim. The text of "canceled" and "not entered" claims must not be presented; and these claims must be indicated as being in the status of "canceled" or "not entered," respectively.

Paragraph (c)(5) requires that a claim canceled in its entirety can only be reinstated if presented as a new claim with a new claim number.

Paragraph (d) requires that any drawing changes be submitted in compliance with § 1.84 on replacement sheets as an attachment to an amendment document. An accompanying detailed explanation of all of the changes should be provided on a separate sheet in the drawing

amendments or remarks section of the amendment document. A marked-up copy of one or more of the figures being amended, with annotations, may also be included to provide further explanation of the changes made. The marked-up version must be labeled as "Annotated marked-up Drawings." Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per § 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. No further drawing submission of the amended drawing figure(s) by applicant would be required, unless applicant is so notified.

In order to bring § 1.121(g) into conformity with earlier changes, "(c)(1)" is changed to "(c) and (c)(1) through (c)(5)."

A new § 1.121(h) has been inserted to require that each section of an amendment (*e.g.*, amendments to the claims, amendments to the specification, replacement drawings, remarks) begin on a separate sheet of the amendment paper.

Previous §§ 1.121(h), (i), and (j) have been redesignated as §§ 1.121(i), (j), and (k), respectively.

Section 1.125

Paragraph (b) has been revised to add a cross-reference to § 1.312 to remind applicants that for submissions of substitute specifications filed after the notice of allowance has been mailed and up to the time of payment of the issue fee, entry of the substitute specification is not a matter of right.

Paragraph (c) of § 1.125 has been revised to require the presentation by applicant of both a marked-up version of the specification (using strike-through or in some circumstances double brackets to indicate deleted subject matter and underlining to indicate added subject matter) and a clean

version without markings. Deleted subject matter must be shown by striking through the deleted text or, in some cases, placing double brackets at the beginning and the end of the deleted text. Double brackets must be used if the deleted text would not be easily perceived using strike-through, such as, the deletion of a punctuation mark or a number. Double brackets may also be used to indicate the deletion of five or fewer consecutive characters. Examples of typical amendments in the revised format will be available on the Office's Internet Web site (<http://www.uspto.gov>).

Section 1.173

Current § 1.173(b)(3) is being replaced by §§ 1.173(b)(3), (3)(i) and (3)(ii) as a conforming amendment, in order to provide consistency between utility and reissue drawing practice.

Section 1.823

Section 1.823 has been amended by revising § 1.823(a)(1) to require that any sheet including a part of a sequence listing not include material other than part of a sequence listing. This change is to facilitate indexing of the specification.

Response to Comments

The Office published a notice proposing changes to the rules of practice to implement electronic maintenance of official patent application records. *See Changes to Implement Electronic Maintenance of Official Patent Application Records*, 68 FR 14365 (Mar. 24, 2003), 1269 *Off. Gaz. Pat. Office* 166 (Apr. 22, 2003) (proposed rule). The Office received twenty written comments (from Intellectual Property Organizations, Law Firms, and Patent Practitioners) in response to this notice. Comments generally in support of a change are not discussed. The comments and the Office's responses to those comments follow:

Comment 1: A number of comments questioned if the Office, after making the proposed change in § 1.3, would continue its practice of providing notice to an applicant, patent owner or third party requester when a paper submitted by that party constituted a failure of proper decorum and courtesy.

Response: The Office will continue to provide written notice that a paper submitted by a party to the Office constitutes a failure of proper decorum and courtesy. Following the mailing of the written notice, the paper will no longer be retained in the public electronic image file wrapper. The paper version will eventually be destroyed